

REMARKS

1. The application was filed with 27 claims. Claims 1-3 and 11-15 have been cancelled, and claims 28 and 29 have been added. Claims 4-10 and 16-29 are pending in the application. Reconsideration by the Examiner in view of the amendments and the following remarks is respectfully requested.

2. In the first rejection, the Examiner states that Claims 21-27 are unpatentable under 35 U.S.C. § 103(a) over U.S. Pat. No. 766,145 to W.N. Greer ("Greer") in view of U.S. Pat. No. 2,543,824 to Beesley et al. ("Beesley"). The Examiner states that Greer discloses all the claimed subject matter except for having a pivotally mounted upper jaw with a spring, and a ratcheting mechanism and incremental teeth on the slide for engagement with the brake. The Examiner also states that Beesley discloses a pivotally mounted upper jaw with a spring and a ratcheting mechanism and incremental teeth on the slide for engagement with the brake. The Examiner also states that it would have been obvious to form the device of Greer with such a jaw and a ratcheting mechanism/incremental teeth "to allow the jaws to be adjusted to grip a workpiece as taught by Beesley et al." Office Action, p. 2, lines 18-19.

Applicants traverse the rejections. The Examiner has suggested a motivation for combining the references, but the motivation is insufficient to overcome the teachings of Greer. Greer's invention is a wrench having a rigid upper jaw and a movable lower jaw. The shank of Greer is not made from a single steel bar, but is specially described as "being made from a bar bent upon itself between its ends, the end portions of the bar being secured to the rigid jaw 2 of the device. Col. 1, lines 40-44. It would have been much easier for Greer to simply use a bar with a round or a rectangular cross-section and attach the rigid jaw 2. Instead, Greer chooses a much more complicated construction, a more expensive construction, so that the handle and the upper jaw remain rigid.

The word rigid is used at least ten times in the two short pages of text of the Greer patent. The rigid jaw 2 is held much more firmly by the two end portions of the bar 1 of Greer than would a single bar. Furthermore, this construction, as well as Greer's description, teaches explicitly against any pivoting motion, since a rigid jaw is

the opposite of a pivoting jaw. Greer's wrench, with two bars, cannot have a pivot point about which the upper jaw can pivot. Greer argues against any wrench in which there would be a movable or pivoting upper jaw, since the wrench of Greer goes out of its way to insure an upper jaw that is held very rigidly on the handle of the wrench.

As the Examiner states, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. *In re Keller*, 642 F.2d 413, 208 U.S.P.Q. 871 (C.C.P.A. 1981). Taken together, the Greer and Beesley references would have suggested no combination to one of ordinary skill in the art, since Beesley teaches a pivoting jaw with a pivot point, while Greer teaches against a pivot point and therefore against a pivoting jaw. These references cannot be combined without impermissible hindsight, in which the Applicants' disclosure is used against them. *In re Deuel*, 34 U.S.P.Q.2d 1210 (Fed. Cir. 1995) (reversing a rejection of claims because of impermissible hindsight in construction of references against the claims). In considering the prior art, a reference must be considered in its entirety, including portions that teach away from the claims. M.P.E.P. 2141.02. Applicants submit that the Examiner's rejection is overcome. The Examiner is therefore respectfully requested to withdraw the rejection of Claims 21-27 under 35 U.S.C. 103(a).

3. In the second rejection, the Examiner rejects Claims 4-7, 16-17, and 29 as unpatentable under 35 U.S.C. § 103(a) over U.S. Pat. No. 766,145 to W.N. Greer ("Greer") in view of U.S. Pat. No. 2128,195 to H. Rhyn ("Rhyn"). The Examiner states that Greer discloses all the claimed subject matter except for having a pivotally mounted upper jaw with a spring biasing the upper jaw toward the lower jaw. The Examiner states that Rhyn discloses a pivotally mounted upper jaw with a spring biasing the upper jaw toward the lower jaw. The Examiner then states that it would have been obvious to one having ordinary skill in the art to form the device of Greer with a spring biasing the upper jaw to the lower jaw to grip the workpiece as taught by Rhyn.

Applicants traverse the rejections. The Examiner has stated a motivation for combining the references, but the motivation is insufficient to overcome the teachings of Greer. As stated in the above section concerning Greer/Beesley, Greer's invention argues against any pivoting motion, since a rigid jaw is the opposite of a pivoting jaw.

A wrench with a single bar may be changed to have a pivot point; but a wrench such as Greer's, with two bars, cannot have a pivot point about which the upper jaw can pivot. Greer thus argues against any wrench in which there would be a movable or pivoting upper jaw, since the wrench of Greer goes out of its way to insure an upper jaw that is held very rigidly on the handle of the wrench.

The references would have suggested, to one of ordinary skill in the art, that the references could not be combined, since Greer teaches a rigid jaw with no possibility of a pivot point, while Rhyn teaches a pivoting upper jaw with a very clumsy movement in the lower jaw. As stated above, only impermissible hindsight will succeed in combining these contradictory references. In considering the prior art, a reference must be considered in its entirety, including portions that teach away from the claims. M.P.E.P. 2141.02. Applicants submit that the Examiner's rejection is overcome. Applicants respectfully request the Examiner to withdraw the rejection of Claims 4-7, 16-17, and 29 under 35 U.S.C. 103(a).

4. In the third rejection, the Examiner has rejected Claims 8-10, 18-20, and 28 under 35 U.S.C. § 103(a) as being unpatentable over Greer in view of Rhyn and further in view of Beesley. The Examiner states that Beesley discloses a ratcheting mechanism/incremental teeth on the slide for engagement with the brake and gripping surface on the jaw. The Examiner states that it would have been obvious to one having ordinary skill in the art to form the device of Greer with a ratcheting mechanism/incremental teeth on the slide for engagement with the brake and gripping surfaces on the jaw to allow the jaws to be adjusted to grip a workpiece as taught by Beesley.

Applicants traverse the rejection of Claims 8-10, 18-20, and 28 over the three references. As noted above, Greer teaches against any pivoting of the upper jaw by requiring and specially constructing a rigid upper jaw that cannot be made with a pivot point that a pivoting jaw would require. Beesley and Rhyn provide wrenches with pivot points, but since Greer teaches against the combination, the references cannot be combined. Accordingly, the three references can be combined only with impermissible hindsight. Greer teaches a rigid jaw with no possibility of a pivot point, while Rhyn and Beesley teach pivoting upper jaws. As stated above, in considering the prior art, a

reference must be considered in its entirety, including portions that teach away from the claims. M.P.E.P. 2141.02. Applicants submit that the Examiner's rejection is overcome, and respectfully request the Examiner to withdraw the rejection of Claims 8-10, 18-20, and 28 under 35 U.S.C. 103(a).

5. Even the improperly combined references do not teach all the elements of the inventions claimed in the rejected claims. For instance, in the first rejection, of Claims 21-27 under 35 U.S.C. § 103(a), independent Claims 21 and 24 claim a method and pipe wrench, respectively, in which a portion of a brake lever extends longitudinally and substantially the same length toward the gripping portion as the lower jaw, or second portion of the lower jaw, extends longitudinally toward the gripping portion. Neither Greer nor Beesley describe or suggest such a limitation. The closest that either comes is the finger-piece 11 of Greer, as drawn in Figs. 1-3 of Greer. Finger-piece 11 of Greer is clearly much shorter than the claimed brake lever of the present application; while the brake lever of the present invention covers and protects a horizontally-mounted spring, the finger-piece of Greer does not even extend the length of Greer's spring, as shown in Figs. 1-2 of Greer. Accordingly, even the improperly combined references do not describe or suggest all the limitations of independent Claims 21 and 24, and their dependent claims. The Examiner is respectfully requested to withdraw the rejections of Claims 21-27.

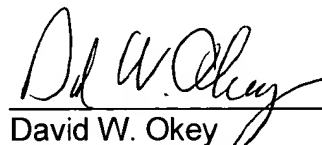
In the same manner, independent Claims 4, 16 and 29 contain similar limitations, a brake lever that extends longitudinally, and substantially the same length toward the gripping portion as the lower jaw or lower portion or second portion extends toward the gripping portion. In the rejections of Claims 4-7, 16-17, and 29, the Examiner cited Greer and Rhyn. Greer and Rhyn, however, describe or suggest no such limitations, and the closest possibility is the finger piece of Greer. As noted above, Greer's finger piece does not extend as far as the brake lever as claimed in the present application. Thus, even the improperly combined references do not describe or suggest all the limitations of Claims 4, 16 and 29, and their dependent claims. The Examiner is respectfully requested to withdraw the rejections of Claims 4-7, 16-17, and 29.

Claims 8-10, 18-20, and 28 are also rejected under 35 U.S.C. § 103(a). These claims depend from Claim 4 of Claim 16, and thus also contain the same limitation of a brake lever as described above. The Examiner has cited Greer, Beesley, and Rhyn against these claims. By the same arguments given above, these references, even improperly combined, do not contain a limitation for a brake lever as described and claimed in the present application. Accordingly, the Examiner is respectfully requested to withdraw the rejections of Claims 8-10, 18-20, and 28.

6. The Examiner has also rejected Claims 4 and 16 under 35 U.S.C. § 112, second para., as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as their invention. Applicants have previously amended Claims 4 and 16 in accordance with the Examiner's suggestion. The Examiner is respectfully requested to withdraw the rejection of Claims 4 and 16 under 35 U.S.C. § 112, second para.

7. Applicants have traversed the rejections and respectfully request that the Examiner withdraw the rejections under 35 U.S.C. § 103(a) and advance the application to allowance. Should the Examiner believe that contact with the undersigned will expedite the allowance of the claims, the Examiner is respectfully asked to call the undersigned at 312-321-4711.

Respectfully submitted,



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APPENDIX A

These claims have deleted portions in brackets and added portions underlined.

4. (Amended three times) An adjustable pipe wrench, comprising:
- a slide bar having a gripping portion;
 - an upper jaw mounted pivotally to the slide bar and a spring mounted between the upper jaw and the slide bar;
 - a lower jaw, slidably mounted on the slide bar, said lower jaw having a lower portion extending toward the gripping portion; and
 - a brake lever, pivotally mounted on a portion of the lower jaw and spring-biased against said lower jaw wherein a portion of the lever extends longitudinally, and substantially the same length toward the gripping portion as the lower [jaw] portion extends longitudinally toward the gripping portion, and wherein a user may adjust a position of the lower jaw on the slide bar by actuating said lever and moving said lower jaw relative to said slide bar.

16. (Amended three times) An adjustable hand clamp, comprising:
- a slide bar having a gripping portion;
 - an upper jaw mounted pivotally to the slide bar and a spring mounted between the upper jaw and the slide bar;
 - a lower jaw, slidably mounted on the slide bar, said lower jaw having a first portion extending toward the upper jaw and a second portion extending in an opposite direction toward the gripping portion; and
 - a brake lever, pivotally mounted on one of said portions of the lower jaw and spring-biased against said second portion of the lower jaw, wherein a portion of the lever extends longitudinally, and substantially the same length toward the gripping portion as the [lower jaw] second portion extends longitudinally toward the gripping portion, and wherein a user adjusts a position of the lower jaw on the slide, by repositioning the lower jaw with a thumb.